

US Serial No. 07/565,673

Page 5

REMARKS

At the time of the present Office Action, the present application had Claims 48, 50 and 53-55 under consideration. Claims 1-40 were previously cancelled. Indeed, the above-identified application has had a long history of prosecution and claim amendments. The presently rejected Claims were principally introduced into prosecution upon the filing of a second submission under 37 C.F.R. §1.129(a) dated December 23, 1998. Applicants have outlined the history of the claim amendments below.

The application was filed on August 10, 1990, with 21 original Claims. A preliminary amendment dated September 23, 1991, cancelled Claim 1 and added new Claim 22. Amendments were made to Claims 2, 3, 4, 5, 6, 7, 8, 9, 10 and 11.

In the response submitted April 24, 1992, Claims 2, 3 and 18 were canceled and Claims 4, 5, 6, 7, 9, 10, 12, 14, 15, 17 and 19 were amended. Further, Claims 20 - 22 were cancelled and essentially rewritten as new Claims 23 - 26.

A further amendment was submitted December 15, 1992, wherein Claims 6, 7, 10, 11, 12, 14, 17, 23 and 26 were amended. In response to a Final Office Action dated March 2, 1993, Claims 9, 14, 17, 19, 23, 24, 25, and 26 were amended and concurrently a Notice of Appeal was filed. An advisory action dated September 27, 1993 indicated the amendment filed in response to the final rejection would not be entered and the Claims remained rejected. An appeal brief was filed March 2, 1994. In response to the Appeal, Appellants received a further non-final Office Action. In reply, Claim 17 was cancelled; Claims 12, 14, 15, 19, 23, 24, 25 and 26 were amended; and Claims 27 - 29 were added.

On July 7, 1995, in response to a Final Office Action dated Feb 14, 1995, Appellants cancelled Claim 16 and amended Claims 9, 12, 19, 23, 24, 25, 26 and 27. The amendment was entered, but the claims remained rejected. A Notice of Appeal was filed. Subsequently, on October 16, 1995, a response was filed under 37 C.F.R. §1.129(a). A Preliminary Amendment filed November 28, 1995 added new Claims 30 - 33. A further amendment dated April 17, 1996 was filed, wherein Claims 4, 13, 14, 19, 23, 24, 25, 26, 28, 29, 30 and 33 were amended and Claims 34 - 37 were added. A non-final Office Action dated September 4, 1996 again rejected pending Claims 4 - 7, 9 - 15, 19, and 23 - 37. In response, Claims 11, 15, 26 - 28 and 36 - 37 were Canceled; claims 4, 5, 6, 7, 9, 10, 12, 13, 14, 23, 29, 30, 34

GC329 Final Office Action Response 12-1-04

BEST AVAILABLE COPY

US Serial No. 07/565,673

Page 6

and 35 were amended and Claims 38 - 40 were added. A Final Office Action dated April 1, 1997 was received, and Appellants filed a Notice of Appeal on Oct. 1, 1997, indicating that the rejections of Claims 7, 9 - 10, 12 - 14, 19, 23 - 25, 29 - 35 and 38 - 40 were to be appealed. However, Appellants did not file an Appeal Brief. When a new representative for Appellants reviewed the file, it was discovered that the application was actually abandoned due to filing the October 16, 1995, 37 C.F.R. §1.129(a) submission subsequent to filing the March 1994 Appeal Brief. On December 23, 1998, Appellants filed a timely petition to revive the unintentionally abandoned application and to accept the first submission made under 37 C.F.R. §1.129(a). Additionally, Appellants filed a second submission under 37 C.F.R. §1.129(a) which included an amendment canceling the pending Claims, 4 - 7, 9 - 10, 12 - 14, 19, 23 - 25, 29 - 35 and 38 - 40 and submitting new Claims 41 - 53. Appellants were notified in a communication from the Petitioner's Office dated August 9, 1999 that (i) the petition to revive the abandoned application was granted; (ii) the rules were waived with respect to the first submission under 37 C.F.R. §1.129(a) and said submission was accepted; and (iii) the second submission under 37 C.F.R. §1.129(a) was accepted.

In response to an Office Action dated June 27, 2000, Claims 44, 49 and 51 were amended. A further amendment was filed July 24, 2001, wherein Claims 41, 45, 47, 48 and 50 were amended and Claims 54 and 55 were added. In Response to a Final Office Action dated October 23, 2001, Applicants filed a Notice of Appeal and subsequent Appeal Brief regarding the rejection of Claims 41 - 55. Pursuant to a decision by the Board of Patent Appeals and Interferences mailed December 24, 2003, prosecution of the present case was reopened, due to the vacating of the Examiner's rejections and remand to the Examiner by the Board. In a Response faxed on August 19, 2004, Applicants have cancelled Claims 41-47, 49, 51, and 52, and amended Claims 48, 50, and 54, without prejudice.

Applicants appreciatively note that the Examiner has withdrawn a majority of the rejections previously made against the Claims. In the present Final Office Action, the Examiner maintained the rejection of Claims 48, 50, and 53-55 under 35 U.S.C. §112, first paragraph as allegedly not meeting the written description requirement.

Applicants appreciate the Examiner's suggestions for amending the Claims and have amended Claims 48, 50, and 54, without prejudice. Claim 55 has been cancelled.

GC329 Final Office Action Response 12-1-04

BEST AVAILABLE COPY

US Serial No. 07/565,673

Page 7

Applicants expressly reserve the right to pursue these and/or broader and/or narrower Claims in subsequently filed applications.

GC329 Final Office Action Response 12-1-04

PAGE 9/10 * RCVD AT 2/1/2005 2:50:05 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/2 * DNIS:8729306 * CSID:650 845 6504 * DURATION (mm-ss):02-52

BEST AVAILABLE COPY


US Serial No. 07/565,673
Page 8

CONCLUSION

All grounds of rejection and objection of the Final Office Action of December 1, 2004, having been addressed, reconsideration of the application is respectfully requested. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned at (650) 846-5838.

Respectfully submitted,

Date: February 1, 2005


Kamrin T. MacKnight
Registration No. 38,230

Genencor International, Inc.
925 Page Mill Road
Palo Alto, CA 94304-1013
Tel: 650 846-5838
Fax: 650 845-6504

GC329 Final Office Action Response 12-1-04

BEST AVAILABLE COPY